

Appl. No. 10/028,196  
Amdt. Dated June 9, 2003  
Reply to Office action of March 11, 2003

### REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claim 1 has been amended. Claims 4-5 have been canceled. No new matter has been added.

The drawings have been objected to. In the enclosed amended drawings, Figures 5 and 6 have been designated by the legend --Prior Art--. The examiner's approval of the proposed changes is requested.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph as being indefinite. Claim 1 has been amended and the antecedent basis has been provided.

Claims 1-3 and 5 stand rejected under 35 U.S.C. 102(a) as being anticipated by Chun (U.S. Patent No. 5,522,295). Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Chun in view of Bollaert (U.S. Patent No. 1,704,962). Claim 1 has been amended. Claims 4-5 have been canceled. For the following reasons, the examiner's rejection is respectfully traversed.

None of the references disclose or suggest that "the upper turret is provided with a notch used in exchanging one of the plurality of lower metal molds" as recited in claim 1. The Office action acknowledges that Chun fails to disclose a notch, but cites Bollaert for these elements (Office action, 03/11/2003, page 3).

Bollaert discloses a notch 68 on the punch bore 30 to provide an opening through which

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the operator may see the point of the punch when aligning the material to be punched (col. 5, lines 4-10). Therefore, Bollaert does not disclose or suggest that the upper turret is provided with a notch used in exchanging one of the plurality of dies. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

Furthermore, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Chun with Bollaert to arrive at the claimed invention. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Chun discloses a punch press. However, there is no suggestion or motivation in Chun to provide for a notch in the upper turret for exchanging one of the dies. Thus, there is no motivation to look at or use the notch elements in Bollaert. The desirability of such a modification is found only in the Applicant's own description of the invention, in contrast to the requirement that the teaching or suggestion to make the modification must be found in the prior art, and not based on an applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Reconsideration and withdrawal of the rejection based upon the combination of references is respectfully requested.

In light of the foregoing, it is submitted that the application as amended is in a condition for allowance and notice to that effect is hereby requested. The references do not disclose or suggest such a punch press as claimed by Applicant and further unsuggested modifications would have to be made to arrive at the presently claimed invention. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone


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interview with the undersigned attorney to expedite prosecution of the application.

If there are any additional fees resulting from this communication, please charge the same  
to our Deposit Account No. 16-0820, our Order No. 34245.

Respectfully submitted,

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